

## REMARKS

Claims 8, 11-12, and 32-34 were pending. By this response, claims 8 and 34 have been amended. Accordingly, claims 8, 11-12, and 32-34 remain pending.

The following remarks are in response to the grounds for rejection of claims set forth in the Office Action.

### Rejections under 35 U.S.C. §102(b)

Claims 8, 11-12, and 32-34 were rejected under 35 U.S.C. §102(b) as being anticipated by Edwards et al. (U.S. Patent No. 6,258,087). In response, and without acceding to any of the grounds for rejecting the claims, claim 8 has been amended to further distinguish the Edwards patent.

In particular, claim 8 recites an apparatus for mapping out endoluminal gastrointestinal surgery that includes an endoluminal support, a plurality of suction ports, and means for leaving an identifiable mark on an outer surface of a portion of tissue. The claim has been amended to recite:

at least a portion of the elongated shaft having a first state in which the portion is substantially flexible and a second state in which the portion is substantially rigid.

These features are supported in the specification at several locations including, for example, at paragraph 0034 and at FIG. 1. In particular, paragraph 0034 states:

Additionally or alternatively, endoluminal support 12 optionally may comprise proximal shaft 13 that is steerable and/or rigidizable or shape-lockable, e.g. via pull wires actuated through handle 15. Rigidizable shafts are described, for example, in Applicant's co-pending U.S. patent application Ser. No. 10/735,030, filed Dec. 12, 2003, which is incorporated herein by reference: When utilizing a steerable, rigidizable shaft, endoluminal support 12 may be steered into proper position within a GI lumen, rigidized to maintain its position, and then actuated as described above to mark tissue and map out endoluminal GI surgery.

FIG. 1 is reproduced below, illustrating an embodiment of a device having an endoluminal support 12 and a proximal shaft 13.

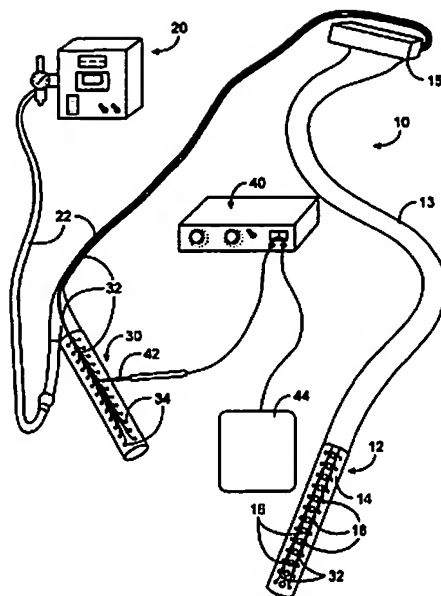
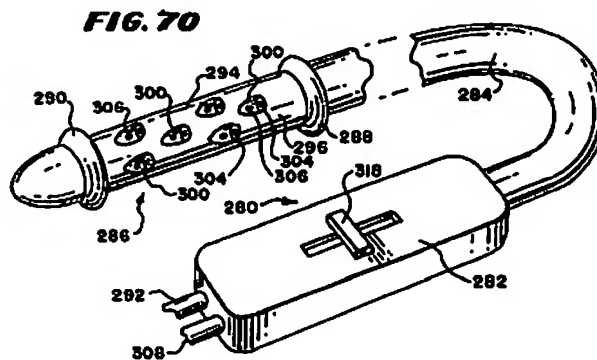


FIG. 1

As noted previously, Edwards' device (see FIG. 70 below) is a treatment device 280 that includes an operative element 286 attached to the distal end of a flexible shaft 284. (Col. 32, ll.



20-38). Nowhere does Edwards teach or describe that the shaft 284 is anything other than flexible, much less that the shaft has a portion having both: (a) a substantially flexible state, and (b) a substantially rigid state, as recited in claim 8. Moreover, there is nothing in the Edwards patent – or in the Jaffe et al. publication (2002/0161281) discussed in the Conclusion section of the Office Action – that suggests that it would have been obvious for any reason to modify the flexible shaft 284 to incorporate these features.

Applicant notes that the amendment of claim 8 incorporates features that were previously contained in claim 34, which has been amended correspondingly. In the “Response to Arguments” section of the pending Office Action (at pages 3-4), it was noted that:

applicant has not substantively argued the merits of the dependent claims, particularly claims 32-34. The examiner now of record maintains that the Edwards et al device inherently provides a suction pump as is evident from the disclosure, and Edwards et al also provide a handle with pull wires as set forth in claim 34.

Without acceding to this contention of what Edwards inherently describes, Applicant further notes that the Office Action does not contend that the Edwards device contains a shaft with a portion having substantially flexible and substantially rigid states.

Accordingly, because the Edwards et al. patent fails to teach at least one element recited in claim 8, there can be no anticipation of the claim. Applicant respectfully requests withdrawal of the rejection of the claim. All of the other claims rejected over the Edwards et al. patent depend directly from claim 8. These claims are, therefore, also patentable for the reasons set forth above.

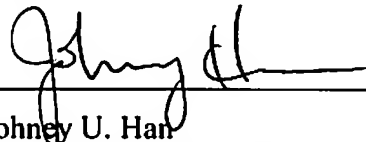
Amendment and/or cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented. Similarly, unless explicitly stated, nothing contained or not contained in this paper should be construed as an assent to any of the Examiner's stated grounds for rejecting the claims, including specifically the Examiner's characterization of the teachings of the cited art and the Examiner's contentions that any combinations of cited art would have been obvious. Rather, the present amendments to the claims and Remarks are an attempt to expedite allowance and issuance of the currently pending claims. No new matter has been added.

### CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections and pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the appropriate fee and/or petition is not filed herewith and the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with this filing to **Deposit Account No. 50-3973** referencing Attorney Docket No. **USGINZ00600**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,



Johny U. Han  
Registration No. 45,565

Charles C. Fowler  
Registration No. 39,675

**Customer No. 40518**  
Levine Bagade Han LLP  
2400 Geng Road, Suite 120  
Palo Alto, CA 94303  
Direct: (650) 242-4217  
Fax: (650) 284-2180